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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/404,715	09/24/1999	TOSHIHISA KUMAKURA	511.37656X00	8711

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EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/404,715

Applicant(s)

KUMAKURA ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3- 14 & 19-27 is/are pending in the application.
- 4a) Of the above claim(s) 22, 23 & 26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-14 and 20 is/are allowed.
- 6) ☒ Claim(s) 1,3-6,19,21,24,25 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,3-14 and 19-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 22, 23 & 26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The originally presented claims(1, 3-14, 19-21, 24, 25 & 27) are drawn to an adhesive composition vs. the newly presented claims(22, 23 & 26) which are drawn to a coated article. The inventions are separate and distinct, each from the other, as per being related as mutually exclusive species in an intermediate-final product relationship, the intermediate product is deemed useful for the coating of non-metal substrates. Presumably a reaction takes place upon deposition of the adhesive onto the metal surface engendering a final product substantially different from the intermediate product, i.e., the intermediate product loses its identity upon deposition to the metal substrate.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22, 23 & 26 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-6, 19, 21, 24, 25 and 27 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cohen et al(U.S. 3,380,831).

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Cohen et al disclose and exemplify photopolymerizable, adhesive compositions, useful for coating operations involving the use of a base substrate which includes those as described in U.S. patent 2, 760,863 to Plambeck, Jr.(incorporated by reference) such as aluminum foil, glass, wood, plastic, etc., wherein said photopolymerizable compositions are defined basically as containing 1) 10 to 99 % by wt. of a macromolecular polymer binder which includes thermoplastic polymer binders such as polyvinyl acetals(sufficient to meet the claimed polyvinyl aetal) and non-thermoplastic(thermosetting) polymer binders, suitable for improving adhesion to the base substrate, such as phenolic resins, melamine-formaldehyde resins etc.(sufficient to meet the claimed thermosetting resin), 2) 5 to 99 wt.% of an ethylenically unsaturated monomer capable of addition polymerization which include polyfunctional(meth)acrylate compounds such as polyoxyethyltrimethylolpropane triacrylate and polyoxyethylpentaerythritol tetra(meth)acrylate(sufficient to meet the claimed polyfunctional (meth)acrylate compounds), 3) 0.001 to 20 wt. % of a polymerization initiator(sufficient to meet the limitations per claim 27), 4) 0.001 to 2 wt.% of an addition polymerization inhibitor and 5) other conventional adjuncts which include fillers such as silica, dyes, pigments, etc.(sufficient to meet the limitations per claim 24). See, e.g., col. 1, lines 44-65 and cols. 9-11 of Cohen et al. Cohen et al therefore anticipate the instantly claimed invention with the understanding that the compositional constituents of Cohen et al overlap in scope with the compositional constituents, as claimed and that the compositional genus disclosed per Cohen et al is sufficiently small enough to engender anticipation of the claimed adhesive composition species as per *In re Schaumann*(572 F 2d 312, 197 USPQ 5 (CCPA 1978)). As to the claimed property limitations per at least claims 1 and 3, it would be expected that the composition of Cohen et al would necessarily possess such since the adhesive composition of Cohen et al is structurally essentially the same as the claimed adhesive composition. Applicant has the burden to show that this, in fact, is not the case(*In re Best et al*(195 USPQ 430)).

As to the dependent claims, the limitations are either taught by Cohen et al, suggested by Cohen et al or would have been obvious to the skilled artisan and with a reasonable expectation of success.

Even if it turns out that the 102(b) portion of the rejection does not apply here, i.e., the claims are not anticipated, it would have been *prima facie* obvious to the skilled artisan to extrapolate the adhesive

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composition, as claimed, from Cohen et al as per such having been within the general purview of the disclosure of Cohen et al and with a reasonable expectation of success

Response to Arguments

5. *Applicant's arguments filed 06/05/03 have been fully considered but they are not persuasive.*

Relative to Cohen et al—The crux of Counsel's extensive arguments appears to hinge on the properties set forth in the claimed invention(claims 1 and 3) not being inherently obtained from the compositions of Cohen et al and relies on the comparative data housed in Tables 1-3 in support of such. To this end, it is urged that a prima facie case of anticipation has been established since the adhesive compositions of Cohen et al are substantially the same as the claimed adhesive compositions and that it would have been expected that adhesive compositions of Cohen et al would necessarily possess the claimed properties. Counsel has simply not rebutted, by iron clad evidence, that the compositions of Cohen et al do not possess the properties of the claimed adhesive composition(In re Best et al, 195 USPQ 430). It is well settled that when a claimed product reasonably appears to be substantially the same as the product disclosed for in the prior art, the burden of proof is on applicants to prove that the prior art product does not inherently or necessarily possess the properties attributed to the claimed product(In re Spada, 15 USPQ 2d 1655 (CAFC 1990)). As to the comparative data, such is too inconclusive to make any determination of patentability since the data is not back-to-back generated. Even if it turns out that the Examiner has somehow missed the boat, the claims are simply not limited to where any improvement might have been shown.

Allowable Subject Matter

6. *Claims 7-14 and 20 stand allowed over Cohen et al as per reasons stated in the previous Office Action per paper no. 12, 03/05/03, paragraph no. 8.*

Conclusion

7. *The additional prior art to Burg et al(U.S. 3,060,023), Celeste et al(U.S. 3,261,686), Podszun et al(U.S. 5,395,730) and Van Damme et al(U.S. 6,010,817) made of record and not relied upon is cited as of interest in teaching adhesive compositions similar to and considered merely cumulative to Cohen et al.*

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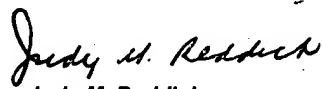
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
08/18/03